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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/701,153	11/03/2003	Paul Raymond Rust	11501.007	5564
25905	7590	12/10/2010		
Intellectual Property Dept. Dewitt Ross & Stevens SC 2 East Mifflin Street Suite 600 Madison, WI 53703-2865			EXAMINER LAUX, JESSICA L.	
			ART UNIT 3635	PAPER NUMBER
			NOTIFICATION DATE 12/10/2010	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docket-ip@dewittross.com

Office Action Summary

Application No.

10/701,153

Applicant(s)

RUST ET AL.

Examiner

JESSICA LAUX

Art Unit

3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/CD)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgment is made of the amendment filed 8/20/2010. The specification, drawings and claims have been amended accordingly.

Response to Arguments

Applicant's arguments with respect to claims 5-27 have been considered but are moot in view of the new ground(s) of rejection.

Accordingly this Office Action is Non-Final.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Russell (7000360) in view of Kartfilt (4852323).

Claims 5,6,7,11,13,14, 16,18,19,22,23,24,26,27. Russell discloses a tape capable of bridging a gap between adjacent building modules and sealably engaging adjacent generally coextensive edge strips of roof membranes covering the modules, the tape comprising:

an elastomeric adhesive layer of EPDM (25) having a tacky lower surface and an oppositely facing upper surface and having a thickness of between approximately 0.040 to 0.060 inch (Russell - Col. 5, lines 34-36);

a release strip (32) temporarily adhered to and covering the tacky lower surface of the adhesive layer, the release strip being removable from the adhesive layer to permit positioning of the tape over the gap between the building modules with the adhesive layer overlapping and adhered to the edge strips of the roof membranes (where the release strip is removable and the tape is capable of the claimed placement); and

comprising a protective outer layer (20) permanently adhered to the upper surface of the adhesive layer

Russell does not disclose a porous reinforcing layer within the adhesive layer.

Simmons discloses a tape (2) for adhering membranes to a roof where the tape comprises an EPDM reinforced with a fabric (Col. 4, lines 39-50; Col. 7, lines 17-32; whereby a fabric has a multiplicity of interstices through which the adhesive can penetrate).

At the time the invention was made it would have been obvious to one having ordinary skill in the art to modify the adhesive of Russell to include a porous reinforcing layer as disclosed by Kartfilt; whereby the tape is sufficiently rigid transversely to form a self supporting bridge resistant to detrimental sagging into a specified gap between the building modules when positioned over the gap with the adhesive layer adhered to the edge strips of the roof membranes (just as applicant's invention is capable of the such a limitation so is the prior art of Russell in view of Kartfilt as disclosed above as there are no features which distinguish applicant's claimed invention from the prior art) to provide

a highly flexible material with low elongation which improves the tapes resistance to wind uplift, peel and shear forces.

Claim 8. The tape according to claim 7, characterized by the scrim material being selected from the group consisting of an absorbent or woven cloth, porous fiberglass fabric, wire or plastic screen mesh, perforated plastic or metal strip, and other permeable or porous material through which a non-solid may penetrate or be forced (Kartfilt - Col. 7, line 17-25).

Claims 9,10. The tape according to claim 6, characterized as being sufficiently flexible longitudinally to permit its being rolled for storage, shipment and handling, and unrolled for application and use and to conform to an angle between on-coplanar edge strips of the roof membranes (where both Russell and Kartfilt disclose flexibility; and just as applicant's invention is capable of the claimed flexibility so is the prior art of Russell in view of Kartfilt as noted above as there are no distinguishing structural features of applicant's claimed invention that enable the claimed function whereby the prior art is not capable).

Claims 12,15,21. The tape according to claim 11, characterized by the adhesive layer comprising a blend consisting primarily of uncured Butyl mixed with other semi-cured polymers to provide the adhesive layer in an initial semi-cured condition and having cross-linked polymers (Russell – Col. 5, lines 6-20).

Claims 17, 20. The tape according to claim 16, characterized as provided to bridge the gap between building modules having roof membranes of a specified base compound (where this is an intended use and the prior art of Russell in view of Kartfilt is

capable of the claimed intended use); and further characterized by the protective outer layer being non-adhesive, of a thickness of between approximately 0.30 inches, and formed of a base compound the same or similar to the specified base compound of the roof membranes (Russell - Col. 4, lines 27-40).

Russell does not disclose that the thickness of the outer layer is between 0.030 and 0.060 inches, but instead discloses a range of 0.25-0.5 inches.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to modify the thickness to be 0.03-0.06 inches because applicant has not disclosed that the thickness dimension provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected the tape of Russell in view of Kartfilt and applicant's invention to perform equally well with either the thickness taught by Russell or the claimed thickness because both devices are comprised of the same materials and structure and therefore would perform the same function of bridging a gap equally well.

Therefore, it would have been prima facie obvious to modify Russell in view of Kartfilt to obtain the invention as specified in claim 17 because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Russell in view of Kartfilt.

Claim 25. The roof system according to claim 23, characterized by (1) providing the tape in a roll with the reinforcing scrim embedded in the adhesive layer and with a release strip temporarily adhered to one of the tacky surfaces of the adhesive layer, (ii)

unrolling the tape and removing the release strip from said one tacky surface, (iii) positioning the tape lengthwise over the gap, and (iv) adhering the lower tacky surface of the adhesive layer to the spaced edge strips of the roof membranes (Russell – Cols. 4-6; where the tape is capable of being provided in a roll and unrolled for installation).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JESSICA LAUX whose telephone number is (571)272-8228. The examiner can normally be reached on Monday thru Thursday, 9:00am to 5:00pm (est).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on 571-272-6843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Jessica Laux/
Examiner, Art Unit 3635